

Office Action Summary

Application No.

10/563,013

Applicant(s)

BORDEAUX ET AL.

Examiner

James Ference

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-35, 38-45 and 47-58 is/are pending in the application.
- 4a) Of the above claim(s) 31, 35, 38-44 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30, 32-34, 45 and 47-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2010 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date: 20101210
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action follows the Non-Final Office action filed on 10/22/2010 to correct claims that were listed as being both withdrawn and rejected.

Currently, claims 30-35, 38-45 and 47-58 are pending. Claims 1-29, 36, 37 and 46 have been cancelled. No new claims have been added. Therefore, claims 30-35, 38-45 and 47-58 remain under consideration.

Election/Restrictions

It is first noted that the most recently filed claims, filed on 03/09/2006, were considered for a restriction requirement (see Restriction Requirement filed on 09/01/2010). However, applicant has noted that claims 1-29 correspond to newly added claims 30-58 (see claims filed 12/30/2005).

Applicant's election with traverse of Group I, including claims 30-57, in the reply filed on 10/01/2010 is acknowledged. The traversal is on the ground(s) that Groups I and II share features which applicant considers to be special technical features. This is not found persuasive because the features listed by applicant, "two projecting parts" and "the pocket formed by the web part and the at least two projecting parts is not open in a direction of the glazed element", do not constitute special technical features under PCT Rule 13.2, but rather are common components of glazing assemblies.

The requirement is still deemed proper and is therefore made **FINAL**.

Applicant's election with traverse of Species A, embodied by Fig. 3B, in the reply

filed on 10/01/2010 is acknowledged. The traversal is on the ground(s) that there is no serious search burden. This is not found persuasive because the burden as been established in the Restriction Requirement.

The requirement is still deemed proper and is therefore made **FINAL**.

Applicant submits that claims 30, 32-35, 45, 47-57 are readable on the elected species. **Thus, claims 31 and 38-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b)**, as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/01/2010.

Claim 35 is withdrawn from further consideration, by the examiner, pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Claim 35 is drawn to Figure 4b which is not part of the elected species. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/01/2010.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s):

- a peripheral frame (claim 30);
- peripheral elements (claim 30); and
- a pocket (claim 30).

No new matter should be entered.

Figures 2, 3a, 4a, 8a and 9a should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to because the drawings are blurry and difficult to read. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

On page 3, the prior art listed as, "American Patent Application No. US 2003/085595" should be changed to US Publication No. 2003/0085595, or US Patent No. 6,773,058.

Appropriate correction is required.

Claim Objections

Claims 47-49, 51, 54 and 55 are objected to because of the following informalities:

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants should use the metric (S.I.) units followed by the equivalent English units when describing their inventions in the specifications of patent applications.

The initials S.I. stand for "Le Système International d' Unités," the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit

measurements made possible by modern technology. See MPEP § 601. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Referring to claim 45: The following limitation is recited, "wherein an internal region of the profile is filled with overmolding material, which material is not capable of exerting any stress whatsoever on the glazed element". The specification, drawings, or claims do not describe the limitation in such a way as to enable one skilled in the art, to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 45: It is unclear how a first object can be capable of exerting no stress whatsoever onto a second object to which the first object is connected. All stresses, no matter how minute or fractional, must be considered. Claim 45 was treated as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30, 32-34, 45, 52, 56 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornils et al. (US Patent No. 5,711,119) ('Cornils').

Referring to claim 30: Cornils provides a glazing unit comprising:

a glazed element (1) provided with a peripheral frame (assembly shown in Fig. 1; peripheral frame comprises 2 and 4) made of plastic (col. 4, lines 12-16) overmolded onto the glazed element, as best understood (overmolded treated as molded over; see col. 3, lines 54-60), the peripheral frame incorporating at least one reinforcing element (4) *for reinforcing the glazed element* (see Fig. 1), the reinforcing element being connected to the peripheral frame (see Fig. 1) by an overmolding plastic, as best

understood (overmolding treated as molding over; col. 4, lines 12-16) and having a profile (as shown in Fig. 1) including a web part (5; horizontal portion of 4 as shown in Fig. 1) arranged substantially parallel and close to the glazed element (as shown in Fig. 1) and that bears at least two projecting parts (6 and 7; vertically projecting flanges of 4) distal to the glazed element (as shown in Fig. 1) and forming a pocket (space bound by web part and two projecting parts, as shown in Fig. 1);

wherein the pocket formed by the web part and the at least two projecting parts is not open in a direction of the glazed element (as shown in Fig. 1).

It is noted that the limitation, "*for reinforcing the glazed element*" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is further noted that claim 30 is a product by process claim because the glazing unit does not depend on the process of making it. The product-by-process limitations, "overmolded" and "overmolding" would not be expected to impart distinctive structural characteristics to the glazing unit. Therefore, the claimed glazing unit is not a different and unobvious glazing unit from Cornils.

Referring to claim 32: Cornils further provides wherein the reinforcing element comprises, longitudinally, a succession of projecting parts of limited extent (6 and 7; vertically projecting flanges of 4).

Referring to claim 33: Cornils further provides wherein the reinforcing element comprises two lateral arms (6 and 7), each arm constituting a projecting part borne by the web part (as shown in Fig. 1).

Referring to claim 34: Cornils further provides wherein the glazing unit has a U-shaped profile (as shown in Fig. 1) with the concavity of the U facing away from the glazing element (as shown in Fig. 1).

Referring to claim 45: As best understood, Cornils further provides wherein an internal region of the profile is filled with overmolding material (13), which material is not capable of exerting any stress whatsoever on the glazed element (as shown in Fig. 1).

Referring to claim 52: Cornils further provides wherein the overmolding plastic includes a thermoplastic (col. 3, lines16-17).

Referring to claim 56: Cornils further provides wherein the glazing unit is used as an automotive glazing unit, as best understood (Fig. 1).

Regarding to the limitation, "as an automotive glazing unit or as a sunroof", it has been held that the recitation with respect to the matter in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex part Masham*, 2 USPQ2d 1647 (1987).

Referring to claim 57: Cornils provides all the limitations of claim 30, in addition to the reinforcing element having a profile (Fig. 1) comprising a web part (5) and at least two projecting parts (4 and 7) in a form of lateral arms, as best understood (Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47-49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornils et al. (US Patent No. 5,711,119) ('Cornils').

Referring to claims 47-49: Cornils provides all the limitations of claim 30 as above. Cornils is silent as to the coefficient of linear thermal expansion of the at least one reinforcing element. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to select a known material having an appropriate coefficient of linear thermal expansion that is appropriate for the application of the glazing unit, such as, for example, an automobile, including, but not limited to, a coefficient of linear thermal expansion above $10^{-5}/^{\circ}\text{C}$, above that of the glass, at least equal to $12 \times 10^{-6}/^{\circ}\text{C}$, or below $8 \times 10^{-6}/^{\circ}\text{C}$, since such a modification would have involved a mere change in known materials. The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when

heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

Further, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to optimize the coefficient of linear thermal expansion as above based on the application and intended use, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 167 F.2d 272, 205 USPQ 215 (CCPA).

Referring to claim 51: Cornils provides all the limitations of claim 30 as above. Cornils is silent as to the range of thickness of the at least one reinforcing element. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to optimize the thickness of the reinforcing element to be between 1.5 and 5 mm in order to best suite the intended use of the glazing unit, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cornils et al. (US Patent No. 5,711,119) ('Cornils') in view of Huchet (FR 2,814,705).

Referring to claim 50: Cornils provides all the limitations of claim 30 as above.

Cornils is silent as to the at least one reinforcing element being made of metal or composite plastic. However, rigid members comprising metal are commonly used for reinforcing glazing unit assemblies or glazing frames, as demonstrated by Huchet (see abstract and specification; Fig. 1; 5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use a rigid core material in the reinforcing element, such as metal, in order to enhance the structural integrity of the assembly, since it is known in the art to use rigid materials such as metal in glazing unit assemblies, as taught by Huchet.

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornils et al. (US Patent No. 5,711,119) ('Cornils') in view of Bravet et al. (US Patent No. 6,265,054) ('Bravet').

Referring to claim 53: Cornils further provide wherein the glazed element has a laminated glass (1), which may or may not be hardened, formed from at least two sheets of glass, as best understood (Fig. 1). Cornils does not explicitly teach wherein the glass is formed of two adjacent sheets with at least one plastic sheet positioned between the two adjacent sheets. However, composite glazing materials comprising two adjacent sheets with at least one plastic sheet positioned between the two adjacent sheets are known in the art. For example, Bravet teaches a hardened composite glazing material comprising at least two glass sheets, with interposition of at least one plastic sheet between two adjacent sheets (claim 1). Therefore, it would have been obvious, at

the time of the invention, to use a composite glazing material as taught by Bravet in the assembly of Cornils in order to prevent damage to the glazing, since composite glazing materials are known in the art, as taught by Bravet.

It is further noted that claim 53 is a product by process claim because the glazing unit does not depend on the process of making it. The product-by-process limitation, *"hardened, formed from at least two sheets of glass, with interposition of at least one plastic sheet between two adjacent sheets"* would not be expected to impart distinctive structural characteristics to the glazing unit. Therefore, the claimed glazing unit is not a different and unobvious glazing unit from Cornils.

Referring to claim 54: Cornils and Bravet teach all the limitations of claim 53 as above. Bravet further teaches wherein the glazed element includes a hardened laminated glass having a total thickness of below 5 mm (claim 1).

Referring to claim 55: Cornils and Bravet teach all the limitations of claim 53 as above. Bravet further teaches wherein the glazed element includes a hardened laminated glass having a total thickness of below 4 mm (claim 12).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Ference whose telephone number is (571) 270-7861. The examiner can normally be reached on Monday - Thursday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William V Gilbert/
Examiner, Art Unit 3635

/J. F./
Examiner, Art Unit 3635